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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARK BECKMANN, HYUN-NAM CHOI and SABINE VAN NIEKERK

Appeal 2009-003468
Application 10/522,345
Technology Center 2600

Decided: August 27, 2009

Before KENNETH W. HAIRSTON, JOHN A. JEFFERY, and CARL W. WHITEHEAD, JR., *Administrative Patent Judges.*

WHITEHEAD, JR., *Administrative Patent Judge.*

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134 from the Examiner's rejection of claims 16-30.[1] *See* App. Br. 8. We have jurisdiction under 35 U.S.C. § 6(b) (2002). We affirm.

STATEMENT OF THE CASE

Appellants invented a method for connecting a wireless local network (WLAN) to a universal mobile telecommunications system (UMTS) terminal station having universal subscriber identity module (USIM)/USIM application tool kit (USAT) functionality that enables the exchange of WLAN specific data, a reliable connection and/or cleardown.[2]

Claim 16 which further illustrates the invention follows:

Claim 16. A method for connecting a wireless local network to a UMTS terminal station having USIM/USAT functionality, the method comprising:

monitoring activity of the wireless local network by the terminal station using an existing connection;

transmitting at least one of a type and an identity number of the wireless local network to the terminal station following successful detection of local network activity;

initiating a logical connection between the wireless local network and the terminal station; and

polling specific subscriber data of the wireless local network for the logical connection.

The Rejections

The Examiner relies upon the following prior art references as evidence of unpatentability:

Lin	US 6,078,811	Jun. 20, 2000

[1] The rejection of claims 16-30 under 35 U.S.C. § 112, second paragraph, has been withdrawn by the Examiner (Ans. 3).
[2] *See generally* App. Br. 6-7 and Spec. 3.

Le	US 6,556,820 B1	Apr. 29, 2003
Reddy	US 2004/0043791 A1	Mar. 4, 2004

Digital Cellular Telecommunications System (Phase 2+)(GSM); Universal Mobile Telecommunications System (UMTS); USIM Application Toolkit (USAT)(3Gpp TS 31.111 version 4.5.0 Release 4) 2001

Claims 16, 17, 19, 23, 24, 26 and 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Reddy and Lin (Ans. 3-9).

Claims 18 and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Reddy, Lin and Le (Ans. 9-10).

Claims 20-22 and 27-29[3] stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Reddy, Lin and 3Gpp TS 31.111 version 4.5.0 Release 4 (Ans. 10-14).

Rather than repeat the arguments of Appellants or the Examiner, we refer to the Briefs and the Answer for their respective details. In this decision, we have considered only those arguments actually made by Appellants. Arguments which Appellants could have made but did not make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2008).

Claims 16, 17, 19, 23, 24, 26 and 30[4]

[3] Appellants state that "claims 16-30 are being appealed" (App. Br. 4), but fail to argue the merits of the rejection of claims 20-22 and 27-29. Since the Appellants have not presented arguments rebutting the Examiner's *prima facie* case of obviousness for these claims, we will sustain the Examiner's rejection of claims 20-22 and 27-29. *See In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

Appellants argue that Reddy does not monitor activity of the wireless local network using an existing connection as set forth in the claims (App. Br. 14). The Examiner agrees that Reddy fails to disclose an existing connection; however, the Examiner indicates that Reddy's mobile unit 200 may communicate with a wireless local area network instead of an IP-based network (Ans. 4 and 14).

ISSUE

Have Appellants shown that the Examiner erred in finding that the combination of Reddy and Lin discloses a method and a device for connecting a wireless local access network to a UMTS terminal station using an existing connection?

FINDINGS OF FACT

1. Reddy discloses that the mobile unit 200 can alternatively communicate with a wireless local area network (WLAN) instead of an IP-based network 410 (¶ [0031]).
2. Reddy discloses that the IP address stored in the mobile unit 200 can be used in situations where the handoff occurs between a cellular system and a WLAN (¶ [0037]).

PRINCIPLE OF LAW

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). In so

[4] As argued by the Appellants (App. Br. 14-16).

doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). If the Examiner's burden is met, the burden then shifts to the Appellant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. *See In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

ANALYSIS

Appellants argue that Reddy does not monitor activity of the wireless local network using an existing connection (App. Br. 14). Appellants further argue that since Reddy operates in an all-IP network, the connection occurs in the physical layer directly to an IP network and therefore, there is no *type* or *identity number* of a wireless local network transmitted at this point since the IP address would have to be known to the user before the connection is attempted (App. Br. 15). The Examiner indicates that Reddy is silent in regards to using an existing connection, but the Examiner does not recognize the full extent of Reddy's disclosure. *See* Ans. 14. The Examiner recognizes that Reddy discloses that the mobile unit can communicate with a wireless local area network instead of an IP-based network (FF 1-2 and Ans. 4). However, the Examiner does not emphasize that because Reddy can operate in a wireless local network, Reddy monitors the activity of the wireless local network by the terminal station by using an existing connection. *See* Ans. 14 and FF 1-2.

Appellants continue to argue that Reddy does not disclose monitoring the activity of the wireless local network by using an existing connection because Reddy's operation occurs within IP-based networks (Reply Br. 2).

However, the Appellants fail to address Reddy's operation with the wireless local network. The rationale provided by Appellants in regards to Reddy failing to disclose an existing connection within IP networks would not apply to wireless local area networks. In a wireless local network environment, Reddy would have to monitor the activity of an existing connection in order to establish connection. Yet the Appellants fail to address Reddy's capability to communicate with a wireless local area network instead of an IP-based network.

Further, claim 23 additionally requires *parts for monitoring activity of the wireless local network using the established connection.* Reddy discloses that the mobile unit 200 can also communicate with a wireless local area network and, therefore, it would have the necessary *parts* to establish the communication. *See* FF 1-2. Claim 30 also requires *parts for monitoring activity of the wireless local network using an existing connection.* Again, Reddy discloses that the mobile unit 200 can also communicate with a wireless local area network and, therefore, it would have the necessary *parts* to monitor the network using the existing connection. *See* FF 1-2.

Once the Examiner has satisfied the burden of presenting a prima facie case of obviousness, the burden then shifts to Appellants to present evidence and/or arguments that persuasively rebut the Examiner's prima facie case. *See In re Oetiker*, 977 F.2d at 1445. As we stated previously, the Appellants failed to address Reddy's use of a mobile unit 200 with a wireless local area network instead of an IP-based network. The Appellants chose instead to rebut the obviousness rejection based upon Reddy's functionality within IP networks. Since Appellants did not particularly point

out errors in the Examiner's reasoning to persuasively rebut the Examiner's prima facie case of obviousness, the rejection is therefore sustained.

We will sustain the Examiner's obviousness rejection of claims 16, 17, 19, 23, 24, 26 and 30.

Claims 18 and 25[5]

Appellant does not separately argue with particularity the limitations of claims 18 and 25 apart from the rejection of claims 16, 17, 19, 23, 24, 26 and 30 (App. Br. 16). Such conclusory assertions without supporting explanation or analysis, particularly pointing out errors in the Examiner's reasoning, fall well short of persuasively rebutting the Examiner's prima facie case of obviousness. *See In re Oetiker*, 977 F.2d at 1445. We therefore sustain the Examiner's rejection of claims 18 and 25 for the reasons indicated previously.

CONCLUSION

Appellants have not shown that the Examiner erred in finding that the combination of Reddy and Lin discloses a method and a device for connecting a WLAN to a UMTS terminal station using an existing connection.

ORDER

We will sustain the Examiner's decision rejecting claims 16-30.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

[5] As argued by the Appellants (App. Br. 16).

AFFIRMED

gvw

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